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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,735	08/19/2003	Lianghe Zuo	022302-000110US	4099
20350 7590 10/09/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER COULTER, KENNETH R	
			ART UNIT 2141	PAPER NUMBER
			MAIL DATE 10/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,735

Applicant(s)

ZUO, LIANGHE

Examiner

Kenneth R. Coulter

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/23/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

The information related to parent Application 10/066517 should be updated to include the fact that 10/066517 is now abandoned.

Appropriate correction is required.

2. Claims 1 and 10 are objected to because of the following informalities:

An extraneous period (claim 1, line 22; claim 10, line 21);

A comma at the end of this line should be a semi-colon for consistency (claim 10, line 16).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 3 and 8 – 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Council et al. (U.S. Pat. Pub. No. 2001/0023432) (Method and Apparatus for Enabling a Fee to be Charged to a Party Initiating an Electronic Mail Communication When the Party is not on an Authorization List Associated with the Party to Whom the Communication is Directed).

4.1 Regarding claim 1, Council discloses a method for blocking unauthorized e-mail to at least one e-mail account comprising the steps of:

providing an e-mail service system for receiving and routing e-mails to the at least one e-mail account (Fig. 1; Abstract; paragraphs 7, 18);

providing an independent e-mail provider for receiving and routing e-mails to the at least one independent e-mail account (Fig. 1; paragraph 18);

interrogating the independent e-mail account on the independent e-mail provider from the e-mail service system to route and receive e-mail messages in the independent e-mail account to an e-mail account on the e-mail service system (Abstract; Figs. 2, 3; paragraphs 10 – 13, 19);

maintaining for each e-mail account an exception list of authorized addressers identified by at least their e-mail addresses (Fig. 2, item 16; Fig. 3, item 32; Abstract “list of parties authorized by the intended receiving party”; paragraphs 11, 19);

providing a payment service system in cooperative operation with the said e-mail service system for executing a required payment from an unauthorized e-mail sender to

assure delivery of e-mail to an intended recipient (Abstract “a fee that will be charged to the sending party”; paragraphs 7 – 9, 19, 23);

receiving e-mail at the e-mail service system from an addresser and comparing the address of the addresser of the e-mail to the maintained exception list of the intended recipient's account; upon finding the address of the addresser of the e-mail on the exception list, forwarding the e-mail to the intended recipient (Fig. 2, items 16, 17, 18; Fig. 3, items 32, 33, 34; paragraphs 10, 11, 19, 21, 23);

upon not finding the address of the addresser of the e-mail on the exception list, checking with the payment service system to see if the addresser has made at least the required payment for forwarding an e-mail to the intended recipient (Fig. 2, items 16, 17, 19; Fig. 3, items 32, 33, 35; paragraphs 10, 11, 19, 21, 24, 26);

upon finding that the addresser has made at least the required payment for forwarding an e-mail to the intended recipient, forwarding the e-mail to the intended recipient; and, upon not finding that the addresser has made at least the required payment for forwarding an e-mail to the addressee, informing the addresser by e-mail that, without the required payment, forwarding an e-mail message from an addresser who is not on the addressee's exception list will not occur (Abstract; Figs. 2, 3; paragraph 30).

4.2 Per claim 2, Council teaches the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and wherein the step of, upon not finding that the addresser has made at least the required payment for forwarding an e-mail to

the addressee, informing the addresser by e-mail that, without the required payment, forwarding an e-mail message from an addresser who is not on the addressee's exception list will not occur occurs directly from e-mail service system to the sender of the original e-mail (Fig. 2, item 23; paragraph 23 "sending party is notified by an e-mail message that it has not authorized fee billing").

4.3 Regarding claim 3, Council discloses the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and wherein the step of, upon not finding that the addresser has made at least the required payment for forwarding an e-mail to the addressee, informing the addresser by e-mail that, without the required payment, forwarding an e-mail message from an addresser who is not on the addressee's exception list will not occur occurs from e-mail service system to the sender of the original e-mail through the independent e-mail provider (Fig. 2, item 23; paragraph 23).

4.4 Per claim 8, Council teaches the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and wherein the step of providing a payment service system in cooperative operation with the said e-mail service system for executing a required payment from a unauthorized e-mail sender to assure delivery of his e-mail to an intended recipient includes:

providing at least one electronic form with at least one field of entry for the account holder's e-mail service provider to set the amount of the required payment for

Art Unit: 2141

delivery of an e-mail from an unauthorized addresser to the said account holder's e-mail account (Figs. 2, 3; paragraphs 19, 24, 33).

4.5 Regarding claim 9, Council discloses the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and including an additional step of:

providing at least one electronic form with at least one field of entry where the addressee can provide password, ID, and other necessary information of the independent email account with the independent e-mail provider such that the step of interrogating the independent e-mail account at the independent e-mail provider from the e-mail service system to route and receive e-mail messages in the independent e-mail account to an e-mail account on the e-mail service system can occur (Abstract; paragraph 29).

4.6 Per claim 10, the rejection of claims 1 – 3, 8, and 9 under 35 USC 102(e) (paragraphs 4.1 – 4.5 above) applies fully.

5. Claims 1 – 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Raymond (U.S. Pat. Pub. No. 2003/0086543) (System and Method for Discouraging Communications Considered Undesirable by Recipients).

5.1 Regarding claim 1, Raymond discloses a method for blocking unauthorized e-mail to at least one e-mail account comprising the steps of:

providing an e-mail service system for receiving and routing e-mails to the at least one e-mail account (Abstract; Fig. 1; paragraphs 15, 16);

providing an independent e-mail provider for receiving and routing e-mails to the at least one independent e-mail account (Fig. 1; paragraph 24 "one or more Internet Service Providers"; paragraph 27);

interrogating the independent e-mail account on the independent e-mail provider from the e-mail service system to route and receive e-mail messages in the independent e-mail account to an e-mail account on the e-mail service system (Abstract; Fig. 2; paragraph 16);

maintaining for each e-mail account an exception list of authorized addressers identified by at least their e-mail addresses (Fig. 2; paragraph 33 "list of acceptable senders' addresses");

providing a payment service system in cooperative operation with the said e-mail service system for executing a required payment from an unauthorized e-mail sender to assure delivery of e-mail to an intended recipient (Abstract; Fig. 2; paragraph 15; paragraphs 33, 34);

receiving e-mail at the e-mail service system from an addresser and comparing the address of the addresser of the e-mail to the maintained exception list of the intended recipient's account; upon finding the address of the addresser of the e-mail on

Art Unit: 2141

the exception list, forwarding the e-mail to the intended recipient (Fig. 2; paragraphs 15, 33, 34);

upon not finding the address of the addresser of the e-mail on the exception list, checking with the payment service system to see if the addresser has made at least the required payment for forwarding an e-mail to the intended recipient (Abstract; Fig. 2; paragraphs 15, 33, 34);

upon finding that the addresser has made at least the required payment for forwarding an e-mail to the intended recipient, forwarding the e-mail to the intended recipient; and, upon not finding that the addresser has made at least the required payment for forwarding an e-mail to the addressee, informing the addresser by e-mail that, without the required payment, forwarding an e-mail message from an addresser who is not on the addressee's exception list will not occur (Abstract; Fig. 2; paragraphs 15, 33, 34).

5.2 Per claim 2, Raymond teaches the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and wherein the step of, upon not finding that the addresser has made at least the required payment for forwarding an e-mail to the addressee, informing the addresser by e-mail that, without the required payment, forwarding an e-mail message from an addresser who is not on the addressee's exception list will not occur occurs directly from e-mail service system to the sender of the original e-mail (Fig. 2; Abstract; Fig. 2, item 210; paragraphs 15, 16, 35 "return message").

5.3 Regarding claim 3, Raymond discloses the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and wherein the step of, upon not finding that the addresser has made at least the required payment for forwarding an e-mail to the addressee, informing the addresser by e-mail that, without the required payment, forwarding an e-mail message from an addresser who is not on the addressee's exception list will not occur occurs from e-mail service system to the sender of the original e-mail through the independent e-mail provider (Fig. 2; Abstract; Fig. 2, item 210; paragraphs 15, 16, 35 "return message").

5.4 Per claim 4, Raymond teaches the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and including an additional step of:

upon receiving and forwarding a reply e-mail from the addressee of a previous e-mail to the addresser of the previous e-mail, reversing the payment made by the sender of the previous e-mail if the sender of the previous e-mail made the required payment to assure the delivery of the previous e-mail to its addressee and the said reply e-mail is sent within a predetermined period of time (paragraph 37 "money is returned or credited back to Party A's account").

5.5 Regarding claim 5, Raymond discloses the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and including an additional step of:

upon receiving and executing a request from the addressee of an e-mail to add to his exception list the address of the addresser who made at least the required payment to assure the delivery of the said e-mail to its addressee, reversing the payment made by the addresser if the said request from the addressee is made within a predetermined period of time (paragraph 37 "money is returned or credited back to Party A's account").

5.6 Per claim 6, Raymond teaches the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and wherein the step of maintaining an exception list for each e-mail account includes:

providing the capability to add all or some of the addresses in the account holder's address book in the independent e-mail provider to the exception list (paragraph 33 "update the database to include new banned senders, or expand or revise the list of acceptable senders' addresses.").

5.7 Regarding claim 7, Raymond discloses the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and wherein the step of maintaining an exception list for each e-mail account includes:

providing the capability to manually add addresses to or delete addresses from the exception list (paragraph 33).

5.8 Per claim 8, Raymond teaches the method for blocking unauthorized e-mail to at

Art Unit: 2141

least one e-mail account according to claim 1 and wherein the step of providing a payment service system in cooperative operation with the said e-mail service system for executing a required payment from a unauthorized e-mail sender to assure delivery of his e-mail to an intended recipient includes:

providing at least one electronic form with at least one field of entry for the account holder's e-mail service provider to set the amount of the required payment for delivery of an e-mail from an unauthorized addresser to the said account holder's e-mail account (paragraphs 34, 42).

5.9 Regarding claim 9, Raymond discloses the method for blocking unauthorized e-mail to at least one e-mail account according to claim 1 and including an additional step of:

providing at least one electronic form with at least one field of entry where the addressee can provide password, ID, and other necessary information of the independent email account with the independent e-mail provider such that the step of interrogating the independent e-mail account at the independent e-mail provider from the e-mail service system to route and receive e-mail messages in the independent e-mail account to an e-mail account on the e-mail service system can occur (Fig. 2; Abstract; paragraph 15).

5.10 Per claim 10, the rejection of claims 1 – 9 under 35 USC 102(e) (paragraphs 5.1 – 5.9 above) applies fully.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Landesmann U.S. Pat. Pub. No. 2002/0052855 System and Method for
Granting Deposit-Contingent E-Mailing Rights

A spam control method that deters senders of unwanted email (spam) by charging a fee (paragraphs 41, 44, 63), including a Hotmail provider (paragraph 17).

Benowitz et al. U.S. Pat. Pub. No. 2003/0236847 Technology Enhanced
Communication Authorization System

A spam suppression system that utilizes a fee and a list of acceptable email addresses (paragraphs 8, 39, 40, 66, 107).

Klug U.S. Pat. No. 7,085,745 Method and Apparatus for Identifying, Managing, and
Controlling Communications

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

Art Unit: 2141

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KENNETH R. COULTER
PRIMARY EXAMINER

krc